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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,187	03/10/2004	Norbert Rick	MERCK-2862	2740

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MILLEN, WHITE, ZELANO & BRANIGAN, P.C.
2200 CLARENDON BLVD.
SUITE 1400
ARLINGTON, VA 22201

EXAMINER

MARCHESCHI, MICHAEL A

ART UNIT	PAPER NUMBER
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1755

MAIL DATE	DELIVERY MODE
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07/06/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/796,187

Applicant(s)

RICK ET AL.

Examiner

Michael A. Marcheschi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9 and 13-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9 and 13-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/23/07 has been entered.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 9 and 13-23 are rejected under 35 U.S.C. 103(a) as being obvious over either (1) Schoen et al. US 2002/0192448 or (2) Schoen et al. (6,884,289) both in view of Andes et al. (2003/0005859).

Schoen et al. US 2002/0192448 is the pre publication of Schoen et al. (6,884,289)

Schoen (US 2002/0192448) teaches an interference pigment comprising: (A) a coating having a refractive index of > 1.8 in a layer thickness of 20 - 250 nm, (B) a colorless coating having a refractive index of 1.8 in a layer thickness of 10 - 100 nm, (C) a colorless coating having a refractive index of > 1.8 in a layer thickness of 20 - 250 nm, (D) an absorbent layer having a layer thickness of 1 - 100 nm, and, optionally, (E) an outer protective layer (see abstract

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and [0010]). Schoen teaches the flake form substrate is natural or synthetic mica, glass flake, alumina flake, silica flake or titania flake, or a mixture thereof (see [0018]). Schoen teaches in sections [0022], [0024] and [0026] materials for coating layers (A), (B), (C) above. Coating (D) can be inorganic pigments (claim 1 of the reference does not limit the pigment to any specific kind, as long as it is an absorbent pigment). Schoen teaches the pigment has industrial applications suitable for the production of flowable pigment preparation and dry preparations (see [0017], [0049] and [0050]). Schoen teaches a pigment composition would comprise one or more binders, interference pigments and optionally one or more additives (see [0049]).

The other Schoen reference teaches the same subject matter as its prepublication counterpart.

These references are silent as to the specific pigments used for layer (D).

Andes teaches in the abstract and [0042], multilayered pigments, wherein the last layer of the pigment is an absorbent layer (i.e. titanium nitride or titanium oxynitride). Section [0049] also implies that phosphates can be absorbent materials.

In view of the above teaching and the fact that the two Schoen references do not limit the absorbing layer to any specific pigment (inorganic)-see claim 1 of references, the skilled artisan would have appreciated and thus found it obvious to use any known inorganic pigment that is a absorbent as the pigment in the layers according to the Schoen references because the use of any known absorbing pigment is clearly within the level of ordinary skill in the art. Assuming arguendo about this, the substitution of one known absorbing pigment for the absorbent material defined by the Schoen references is clearly within the level of ordinary skill in the art because they are used for the same purpose. The motivation being that Andes teaches that these materials

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are used to provide the absorbent layer in multilayered pigments (i.e. interference pigments) and the Schoen references do not limit the absorbent material to any specific pigment (see claim 1 of the references). Although Andes does not specifically state that the absorbing materials are pigments, it is the examiners position that since the materials are absorbent materials and an absorbent material is generally colored, they are pigments because the definition of a pigment is a colored material.

In view of this claims 1-7, 9, 13-20 and 22-23 are met.

Claim 21 is obvious because although the references does not literally teach the combination of substrate materials, it is prima facie obvious to combine two or more materials (substrate) disclosed by the prior art to form a third material (combination of substrate materials) that is to be used for the same purpose. In re Kerkhoven 205 USPQ 1069.

Claims 1-7, 9 and 13-23 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,884,289 in view of Andes et al. (2003/0005859).

The claims of 6,884,289 teach the claimed sequence of coating layers but fails to define the instantly claimed absorbent material used in coating layer (D). In fact, claim 1 of reference does not limit the absorbing layer to any specific pigment (inorganic), thus the skilled artisan would have appreciated and thus found it obvious to use any known inorganic pigment that is a absorbent as the pigment in the layer according 6,884,289 because the use of any known absorbing pigment is clearly within the level of ordinary skill in the art. The motivation being that Andes teaches that these materials are used to provide the absorbent layer in multilayered

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pigments (i.e. interference pigments) and 6,884,289 does not limit the absorbent material to any specific pigment (see claim 1). Although Andes does not specifically state that the absorbing materials are pigments, it is the examiners position that since the materials are absorbent materials and an absorbent material is generally colored, they are pigments because the definition of a pigment is a colored material.

In view of this claims 1-7, 9, 13-20 and 22-23 are met

Claim 21 is obvious because it is prima facie obvious to combine two or more materials (substrate) disclosed by the prior art to form a third material (combination of substrate materials) that is to be used for the same purpose. In re Kerkhoven 205 USPQ 1069.

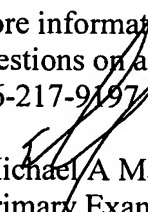
Applicant's arguments with respect to all the claims have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Marcheschi whose telephone number is (571) 272-1374. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

5/07
MM


Michael A Marcheschi
Primary Examiner
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